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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/576,885

04/24/2006

Mitsuo Kimura

JFE-06-1071

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EXAMINER

FOGARTY, CAITLIN ANNE

ART UNIT

PAPER NUMBER

1793

MAIL DATE

DELIVERY MODE

09/02/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/576,885	Applicant(s) KIMURA ET AL.	
	Examiner CAITLIN FOGARTY	Art Unit 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25,27-29,31,35,36 and 48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25,27-29,31,35,36 and 48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. Claims 25, 27 – 29, 31, 35, 36, and 48 are pending where claims 25, 35, and 36 are amended. Claims 1 – 24, 26, 30, 32 – 34, and 37 – 47 have been cancelled.

Acknowledgement of RCE

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 22, 2008 has been entered.

Status of Previous Rejections

3. The provisional rejection of claims 25 – 36 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 – 12 of copending Application No. 10/568, 154 has been withdrawn in view of the amendment filed on July 28, 2008 and the amendments to the claims in copending Application No. 10/568,154.

4. The following rejections are maintained:

- Claims 25, 27 – 29, 31, 35, 36, and 48 under 35 U.S.C. 103(a) as being unpatentable over Kushida et al. (US 6,379,821) in view of the *ASM Handbook*. The previous rejection of claim 34 is withdrawn since claim 34 has been cancelled.

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 25, 27 – 29, 31, 35, 36, and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kushida et al. (US 6,379,821) in view of the *ASM Handbook*.

Kushida in view of the *ASM Handbook* is applied to claims 25, 27 - 29, 31, 35, 36, and 48 as set forth in the April 28, 2008 Office action.

In regards to the amended instant claims 25, 35, and 36, the abstract and col. 3 line 3 to col. 4 line 17 of Kushida teach that the microstructure of the stainless steel is desirably 55 – 90 volume% martensite phase and 10 – 45 volume% ferrite phase which overlaps with the ranges recited in instant claims 25 and 35. Furthermore, Table 6 examples 1, 2, 5, and 10 - 12 of Kushida disclose species with stainless steel compositions within the ranges of claim 25 that have microstructure within the ranges recited in claims 25 and 35. Kushida does not specifically disclose that the stainless steel compositions contain residual austenite phase as recited in instant claims 25 and 36. However, it is known in the art that a martensitic phase results from quenching steel with an austenitic phase. Therefore, since Kushida does not teach 100% conversion from austenite to martensite one of ordinary skill in the art would have expected that the base metal of Kushida would contain residual austenite phase.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory

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obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 25, 27 – 29, 31, 35, and 36 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 24 – 35 of copending Application No. 10/568,154. Although the conflicting claims are not identical, they are not patentably distinct from each other because the composition of the high strength stainless steel seamless pipe recited in 10/568,154 overlaps in scope with the composition of the stainless steel seamless pipe recited in claims 25, 27 – 29, 31, 35, and 36 of the instant application. It would have been obvious to one of ordinary skill in the art at the time the invention was made to select the claimed stainless steel seamless pipe composition from the stainless steel pipe alloy composition recited in 10/568,154 because 10/568,154 teaches the same utility (i.e. pipes to hold oil) in the whole disclosed range.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

9. Applicant's arguments filed July 28, 2008 have been fully considered but they are not persuasive.

Arguments are summarized as follows:

a. Applicant's steel pipes simultaneously have all three of an austenite phase, a ferrite phase, and a martensite phase. The corresponding microstructure from Kushida only comprises a martensite phase and a ferrite phase. There is no austenite phase in any amount. This is an important difference because Applicants have discovered that the austenite phase provides the desired toughness sought by the Applicants. Although Kushida discloses the presence of an austenite phase, the austenite phase is limited to the weld material and is only in combination with the martensite phase. There is no combination in Kushida wherein an austenite phase, a martensite phase, and a ferrite phase are present in the steel at the same time. The structures in Kushida are instead quite different.

b. Assuming the validity of the position in the rejection that it would be obvious to substitute a seamless pipe for a welded pipe, that substitution would make no difference by applying the teachings from the ASM Handbook to Kushida. The result in that case would be a seamless stainless steel pipe having a martensite and ferrite phase microstructure which is not what the Applicants claim.

Examiner's responses are as follows:

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a. As discussed above in the 35 U.S.C. 103(a) rejection, Kushida teaches that the microstructure of the stainless steel is desirably 55 – 90 volume% martensite phase and 10 – 45 volume% ferrite phase. Kushida does not specifically disclose that the stainless steel compositions contain residual austenite phase. However, it is known in the art that a martensitic phase results from quenching steel with an austenitic phase. Therefore, since Kushida does not teach 100% conversion from austenite to martensite one of ordinary skill in the art would have expected that the base metal of Kushida would additionally contain residual austenite phase.

b. Since one of ordinary skill in the art would have expected that the base metal of Kushida would contain residual austenite phase in addition to the martensitic and ferritic phases as discussed above in the 35 U.S.C. 103(a) rejection, it would be expected that the microstructure of the seamless steel pipe of Kushida in view of the ASM Handbook would also contain all three phases.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CAITLIN FOGARTY whose telephone number is (571)270-3589. The examiner can normally be reached on Monday - Friday 8:00 AM - 5:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Roy King/
Supervisory Patent Examiner, Art
Unit 1793

CF